

Remarks

In the Office Action, claims 1-66 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Although this rejection is traversed by Applicants for the reasons set forth below, for completeness, **Applicants provisionally elect claims 1-10, 30-40 & 63 for prosecution at this time.**

In this regard, Applicants note that there is a discrepancy in the Office Action as to the number of claims deemed sufficient to properly define Applicants' invention. In line 9, of page 2, 25 claims are deemed sufficient, which is then followed by the number 20 in the same line, as well as in line 11 of the same sentence. Applicants' have herein provisionally elected 21 claims, four of which are independent. It is respectfully submitted that these 21 claims comprise a reasonable number of claims for the Examiner's consideration. However, should the Examiner require no more than 20 claims for examination at this time, then Applicants provisionally elect claims 1-10, 30-39 & 63 for the Examiner's consideration.

Notwithstanding the above, Applicants respectfully, but most strenuously, traverse the rejection to claims 1-66 under 35 U.S.C. §112, second paragraph. As alluded to by the Examiner at page 2, line 24 – page 3, line 4 of the Office Action, Applicants believe that multiple inventions are presented in their application and recited in their claims. Because of the close relationship between the different inventions, the inventions have been described and claimed in a single application for the Examiner's initial consideration. Specifically, four claim sets are presented. These sets are as follows:

Set I: Claim 1-10, 30-40 & 63;

Set II: Claims 11-17, 41-48 & 64;

Set III: Claims 18-29, 49-58 & 65; and

Set IV: Claims 27-29, 59-62 & 66.

Within each claim set, four independent claims are set forth. That is, Set I includes independent claims 1, 30, 40 & 63; Set II includes independent claims 11, 41, 48 & 64; Set III includes independent claims 18, 49, 58 & 65; and Set IV includes independent claims 27, 59, 62 & 66. Within each claim set, a method claim is provided (i.e., independent claims 1, 11, 18 &

27), a means plus function claim is set forth (i.e., independent claims 30, 41, 49 & 59), a computing unit system claim is provided (i.e., independent claims 40, 48, 58 & 62), and a Beauregard claim is stated (i.e., independent claims 63, 64, 65 & 66). Thus, within a given claim set, there are only four independent claims, and the total number of claims for each claim set is less than 20, with the exception of claim Set I, which has 21 claims. Applicants respectfully submit that the number and type of claims are reasonable in view of the different inventions involved, and when viewed in this context, do not obfuscate the various inventions. Further, Applicants specifically omitted dependent claims from independent claims 40 & 63 of Set I, as well as from independent claims 48, 64 of Set II, independent claims 58, 65 of Set III, and independent claims 62, 66 of Set IV. These omission of dependent claims, in part, were the result of Applicants' desire not to obfuscate the inventions.

As noted in MPEP 2173.05(n), undue multiplicity rejections based on 35 U.S.C. §112, second paragraph, should be applied judiciously, and should be rare. In Ex parte Birnbaum, 161 USPQ 635, 637, the Patent Office Board of Appeals stated that:

While forty pages of claims may seem to be unnecessary prolix, the mere psychological reaction to this amount of material does not, in and of itself, constitute a legal basis for rejection. The Examiner must show either that the claims are so unduly multiplied that they are difficult to understand, or that the claims are for the most part duplicates.

Since the Office Action does not assert that claims are for the most part duplicates, Applicants understand the rejection to be based on an allegation that the claims are difficult to understand. However, Applicants respectfully submit that when viewed as outlined above as four distinct claim sets, then the claims are readily understandable. Further, Applicants respectfully submit that each claim is relatively brief and clear in its meaning.

Still further, the burden of establishing reasonableness of a rejection of undue multiplicity based on 35 U.S.C. §112, second paragraph, rests with the Examiner. In support of the rejection, the Office Action does not review the substance of the claims at issue, but rather merely asserts statistics regarding numbers of independent claims in filed applications, as well as total number of claims in issued patents. Still further, the Office Action references the claim fee changes that became effective December 8, 2004, as evidence of what is considered unreasonable. Applicants respectfully traverse these statements in support of the reasonableness of the multiplicity rejection.

First, Applicants respectfully submit that it is unfair to cite changes in December, 2004 as evidence as to what is considered reasonable at the time this application was filed in November, 2001. As noted above, there are differences between the independent claim sets recited which amount to patentable differences, and that these differences in the independent claim sets are readily understandable by one skilled in the art. Further, Applicants have paid the fees for examination of all claims submitted with their application as then in effect in November, 2001. A change in the subsequent Fee Schedule during the almost four-year pendency of this application is not a fair basis to assert the unreasonableness of the claims presented.

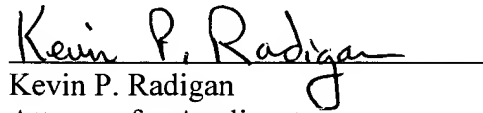
Secondly, the remaining support for the unreasonableness of the claims presented is merely statistics regarding the number of independent claims in filed applications, and the number of issued claims in patents, neither of which represents an absolute bar to future applications. Rather, it is submitted that the pending claims at issue should be examined in light of the subject matter claimed to determine whether the number of claims submitted are unreasonable. No analysis along this line, however, is provided in the Office Action.

For the above reasons, Applicants respectfully submit that the support set forth in the Office Action for the unreasonableness of the number of claims submitted fails to state a *prima facie* case of indefiniteness under 35 U.S.C. §112, second paragraph. As such, reconsideration and withdrawal of the rejection is respectfully requested.

Consideration and allowance of provisionally elected claims 1-10, 30-40 & 63 are respectfully requested. Further, Applicants request reconsideration and withdrawal of the 35 U.S.C. §112, second paragraph, rejection to claims 1-66 of the initial Office Action for the reasons set forth above. Notwithstanding the existence of multiple inventions, consideration of more than one claim set is respectfully requested in view of the probable overlapping class and subclass examinations required for the different claim sets.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



Kevin P. Radigan
Attorney for Applicants
Registration No.: 31,789

Dated: April 28, 2005.

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579